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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/621,294 | 07/17/2003 | Reid Lee | 5150-40801 | 2482 |

7590 11/03/2006
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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/621,294

Applicant(s)

LEE, REID

Examiner

Naeem Haq

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicant has argued that the examiner's restriction is improper because the examiner's interpretation of the term "second user input" in claim 77 is incorrect (see Remarks page 2). The examiner respectfully disagrees and notes that the Applicant does not clarify what this term means. In the absence of such clarification, the examiner interprets this limitation to refer to a "second user". Furthermore, because the limitations "first user" and "second user" are not found in claims 1-76, the examiner maintains that the search strategy required for claims 77-80 is different and distinct from the search strategy required for claims 1-76. The examiner finds the additional searching burdensome. If the Applicant disagrees then the Applicant should clarify what the terms "first user input" and "second user input" mean or state that claims 77-80 are obvious over claims 1-76 or amend claims 77-80 to be consistent with claims 1-76.

The Applicant has also argued that the examiner's objection to Figures 1 and 5 should be removed and states that "...simply because the Figures have been designated prior art in a previous case does not constitute sufficient reasoning for doing so in the present Application." (see Remarks page 4). The examiner respectfully disagrees and invites the Applicant to cite case law or a PTO rule to support this position. In the absence of any such support, the examiner maintains that Figures 1 and 5 are prior art as evidenced by Figures 1 and 5 of US patent 6,985,876.

The Applicant has also argued that the Examiner's rejection under 35 USC 103(a) is improper because Motomiya is non-analogous art and the examiner has used hindsight reconstruction (see Remarks pages 4-6). The examiner respectfully disagrees. Motomiya is directed to the same field as Henson and IBM (i.e. computer-based product configuration). Furthermore, the motivation to combine comes from Motomiya and not the Applicant's specification. For this reason, the examiner maintains the art rejection.

The Applicant has also argued that the examiner's treatment of the term "measurement system" in claim 17 is improper. The examiner respectfully disagrees. MPEP 2106(IV)(B)(1)(b) clearly sets forth the guidelines for determining whether or not nonfunctional descriptive material is present in claim language by stating the following: "Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer." Thus the analysis requires the examiner to determine whether or not the particular piece of data creates any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer. In the present, the examiner cannot find any such functional interrelationship with the term "measurement system". For this reason, the examiner maintains the art rejection.



Naeem Haq, Primary Examiner